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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,323	07/13/2001	Kurt R. Marko	10006139-1	6749

7590

06/19/2006

## HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/905,323

Applicant(s)

MARKO, KURT R.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/13/2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/13/01 & 3/25/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 14, 20, 21, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claims 14, 20, and 26**, the term "substantially equal to" is a relative term which renders the claim indefinite. The term "substantially equal to" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear to what degree the redemption frequency is supposed to be equal to a confidence of an association rule.

**Regarding claim 21**, the claim appears to be directed to a processor that comprises a "site". It is unclear how a processor may comprise a "site".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 1-4, 7, and 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden (U.S. Patent No. 6,912,505) in view of Herz (U.S. Patent No. 6,571,279).**

**Regarding claims 1-4, 7, 8, 11, 12, 15-18, 21-24, and 27,** Linden teaches the identifying of items in a current transaction, the targeting and selecting of coupons based on those items, and the printing of those coupons on the back of a receipt (Column 30, Lines 59-61 and Column 31, Lines 1-9). Linden does not specify a method of selecting the coupons based on expected value. Herz teaches a system of targeting coupons to users based on a profit maximizing strategy (Column 23, Lines 56-58) in which coupons are selected for the user by predicting which coupons will best support the vendor's marketing strategy (Column 23, Lines 56-64). The system of Herz also takes into account user purchases (Column 22, Lines 64-67) and prints the coupon (Column 24, Lines 12-14). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the current-transaction targeted coupons of Linden with the profit-maximizing coupons of Herz. This will aid in the retention of customers while simultaneously maximizing the profit for the retailer. By determining which coupons to print, the system inherently performs priority ranking. As the expected value changes, the coupon appearance changes (Herz, Column 24, Lines 34-36).

**Regarding claims 13, 14, 19, 20, 25, and 26,** Herz teaches the keeping track of coupon usage (Column 22, Lines 64-67 and Column 23, Line 1) and using past

purchase history as well as profit-maximization to select coupons (Column 24, Lines 22-24 and Lines 34-36).

**3. Claims 5, 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden (U.S. Patent No. 6,912,505) in view of Herz (U.S. Patent No. 6,571,279), and further in view of DeLapa (U.S. Patent No. 6,076,068).**

**Regarding claims 5 and 6**, neither Linden nor Herz specify a choosing the number of coupons based on quantity of items purchased or total purchase price. DeLapa teaches printing more coupons for households with more accumulative purchases (the more items that are bought, the higher the total purchase price will be) (Column 5, Lines 18-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide more coupons to consumers who purchase more items, and thereby, the consumers get rewarded for retailer loyalty.

**Regarding claims 9 and 10**, neither Linden nor Herz specify changing the appearance of the coupons based on quantity of items purchased or total purchase price. DeLapa teaches a targeted coupon printing method in which household-specific messages may be printed with the coupons (thus changing the appearance). The messages are determined according to household characteristics, and those household characteristics (characteristics) include accumulative purchases (the more items that are bought, the higher the total purchase price will be) (Column 5, Lines 18-22 and Column 13, Lines 42-53).

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to coupon distribution methods:

U.S. Pub No. 2005/0102202 to Linden

U.S. Patent No. 6,749,240 to Burr

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**JEFFREY D. CARLSON  
PRIMARY EXAMINER**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**JEFFREY D. CARLSON**  
**PRIMARY EXAMINER**